

REMARKS

Applicants appreciate the Examiner's thorough examination of the application and request reexamination and reconsideration of the application in view of the preceding amendments and the following remarks.

As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Applicants respectfully request reconsideration of the present application in view of the above amendments and the following remarks.

Through the above amendments, Applicants have amended claims 1 and 14. Support for these amendments can be found at least at Paragraph [0034] of the subject application. No new matter has been added through the above amendments. Accordingly, claims 1-30 remain pending.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected claims 1-10, 12, 14-23, 25, and 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Miller et al. (U.S. Publication No. 2002/0082519) in view of Moore (U.S. Patent No. 2,866,457). Applicants respectfully traverse the rejections.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Independent claim 1 as amended is directed to a biopsy system, comprising a vacuum assisted biopsy device, a first fluid source, a second fluid source, a fluid connector configured to provide the first and second fluid sources in communication with the biopsy device, the fluid connector comprising a body member having a first input port in fluid communication with the first fluid source, a first check valve in fluid communication with the first input port, the first inlet port

adapted to mate with the first check valve, a second input port in fluid communication with the second fluid source, a second check valve in fluid communication with the second inlet port, the second inlet port adapted to mate with the second check valve, and an outlet port in fluid communication with the vacuum assisted biopsy device, wherein the first check valve is selectively opened when a vacuum is created in the fluid connector.

The Examiner alleged that Miller discloses all of the features of claim 1, except for disclosing that the first valve is a check valve, and that the fluid connector includes a second check valve for providing the second fluid source in communication with the biopsy device. The Examiner further alleged that Moore teaches a fluid connector comprising a first valve comprising a check valve in communication with a first inlet port and selectively opened by a change of pressure within an outlet port, and a second check valve for providing the second fluid source in fluid communication with a fluid connector. The Examiner asserted that it would be obvious to combine the components as taught by Miller with the components as taught by Moore. Applicants respectfully disagree.

Figure 12 of Miller is reproduced below:

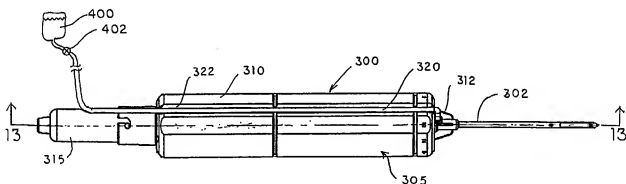


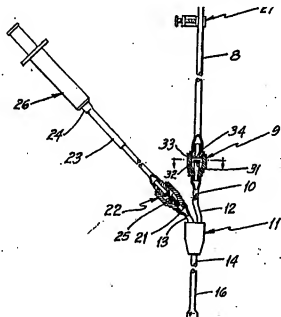
FIG. 12

Miller discloses a disposable tissue removal device including a biopsy apparatus 300, a cannula hub 312 which provides a fluid interface for external secondary lumen 320, and a saline bag 400. Pinch valve 402 can engage the secondary lumen 320 adjacent saline bag 400 to control the timing of fluid flow through lumen 320 and cannula hub 312. See Paragraphs [0141] – [0143] and Fig. 12 of Miller.

As noted above, independent claim 1 includes the features of a first check valve in fluid communication with the first input port, the first inlet port adapted to mate with the first check valve, and a second check valve in fluid communication with the second inlet port, the second inlet port adapted to mate with the second check valve. Independent claim 14 also includes these features.

As admitted by the Examiner, Miller fails to disclose a second check valve. Additionally, nowhere does Miller disclose a body member having first and second input ports, let alone the first input port adapted to mate with the first check valve, and the second input port adapted to mate with the second check valve as claimed by Applicants.

Moore also fails to disclose a body member having first and second input ports, the first input port adapted to mate with the first check valve, and the second input port adapted to mate with the second check valve as claimed by Applicants. Moore is directed to an apparatus for administration of parenteral fluid, and a portion of Figure 1 of Moore is reproduced below:



Moore discloses a connection 11, which includes a first inlet leg or inlet passage 12, a second inlet leg or passage 13, and an outlet leg or passage 14. Check valve 9 is connected by tubing 10 to connection 11. Second leg 13 is connected by a short length of tubing 21 to a second check valve 22. See Col 1, line 61 – Col 2, line 1 and Fig. 1 of Moore.

As noted above, independent claim 1 includes the features of the first input port adapted to mate with the first check valve, and the second input port adapted to mate with the second check valve. Contrary to this, Moore does not disclose first and second input ports that are adapted to mate with first and second check valves respectively. The check valves of Moore are separated from connection 11 by tubing 10 and 21. Check valves 9 and 21 of Moore are connected to tubing 10 and 21 respectively, which are in turn connected to first leg 12 and second leg 13 respectively. Check valves 9 and 21 of Moore are not mated with first leg 12 and second leg 13 of connection 11. Accordingly, as first and second legs 12, 13 of Moore are connected to tubing 10 and 21, first and second legs 12, 13 are not adapted to mate with the check valves as claimed by Applicants.

As both Miller and Moore fail to disclose a first check valve in fluid communication with the first input port, the first inlet port adapted to mate with the first check valve, and a second check valve in fluid communication with the second inlet port, the second inlet port adapted to mate with the second check valve, the combination of references fails to disclose all of the features of independent claim 1. Therefore, independent claim 1, and dependent claims 2-10, 12, 27 and 28, all of which depend from claim 1, are patentable over the references for at least this reason. Moreover, it should be noted that dependent claims 2-10, 12, 27 and 28 each contain additional recitations that are separately patentable as well.

As noted above, independent claim 14 also includes the features of the first input port adapted to mate with the first check valve, and the second input port adapted to mate with the second check valve. Therefore, for at least the reasons set forth above, the combination of Miller and Moore fails to disclose all of the features of independent claim 14. Accordingly, independent claim 14, and dependent claims 15-23, 25, 29 and 30, all of which depend from claim 14, are patentable over the references for at least this reason. Moreover, it should be noted that dependent claims 15-23, 25, 29 and 30 each contain additional recitations that are separately patentable as well.

The Examiner rejected claims 11, 13, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Miller et al. (U.S. Publication No. 2002/0082519) in view of Moore (U.S. Patent No. 2,866,457) and further in view of Turturro et al. (U.S. Patent No. 6,331,165).

As noted above, Miller and Moore both fail to disclose the first input port adapted to mate with the first check valve, and the second input port adapted to mate with the second check valve as

claimed in independent claims 1 and 14 of the subject application. The Examiner alleged that Turturro discloses a biopsy system comprising luer fittings for the purpose of providing quick and easy connection and disconnection. However, Turturro does not make up for the deficiencies in the teachings of Miller and Moore described above. Nowhere does Turturro disclose, teach or suggest a body member having a first input port adapted to mate with the first check valve, and a second input port adapted to mate with the second check valve as claimed by Applicants.

Therefore, for at least the reasons set for above, claims 11 and 13, which depend from independent claim 1, and claims 24 and 26, which depend from independent claim 14, are patentable over the combination of references.

Conclusion

In view of the above amendments and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65937-0045 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: June 30, 2009

Respectfully submitted,

Electronic signature: /Jason D. Shanske/
Jason D. Shanske
Registration No.: 43,915
Kristin L. Murphy
Registration No.: 41,212
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 82078
Attorneys for Applicant